

REMARKS

INTRODUCTION

In view of the following, reconsideration of the allowability of the pending claims is respectfully requested.

New claims 12-22 are merely claims 1-11 previously pending at the time of issuance of the October 17, 2001 Office Action. As noted below, the previously relied upon, and currently relied upon Ishikawa et al., U.S. Patent No. 5,600,455, is not a proper reference under 35 USC § 103(c). Therefore, the previous pending claims 1-11, previously rejected based upon Ishikawa et al., have been added back into the present application.

REJECTION UNDER 35 USC 103

The outstanding Office Action sets forth that claims 4-6 and 9 stand rejected under 35 USC § 103(a) as being obvious over Ishikawa et al.

However, as detailed in MPEP 2146, (August 2005 version) regarding 35 USC § 103(c), "It is to be noted that, for all applications (including reissue applications), if the application is pending on or after December 10, 2004, the 2004 changes to 35 U.S.C. 103(c), which effectively include the 1999 changes, apply; thus, the November 29, 1999 date of the prior revision to 35 U.S.C. 103(c) is no longer relevant."

35 USC § 103(c) sets forth: "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person."

Thus, based upon the aforementioned recent changes to 35 USC §103(c), if the relied upon reference and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person, then the relied upon reference cannot be used in a § 103(a) rejection.

Here, Ishikawa et al. was commonly owned and assigned, and pending after the filing of the present application, i.e., as Ishikawa et al. would only fall under § 102(e), Ishikawa et al. cannot be used in a § 103 rejection over the presently claimed invention.

Accordingly, withdrawal of the outstanding § 103 rejections based on Ishikawa et al. are respectfully requested. In addition, as previous recitations of claims 1-11 were previously only rejected based upon similar § 103 rejections relying on Ishikawa et al., these previous recitations of claims 1-11 are again added to the present application as claims 12-22.

REJECTION UNDER 35 USC 112

The Office Action has objected to the previous reference in independent claim 4 of the "said prismatic surface having repeated projections, each having first and second slopes inclined with respect to the plane of said light control element, said first slopes being directed to said incidence end face of the light guide plate and said second slopes being directed oppositely to said incidence end face of the light guide plate."

Here, each projection has a first slope and a second slope.

In particular the Office Action has set forth that the claimed first slopes being directed to said incidence end face of the light guide plate is not supported by the specification of the present application. However, FIGS. 3 and 6-8 clearly illustrate first slope M1 being inclined with respect to the plane of the light control element and directed to the incidence side face of the light guide plate. Also see FIG. 12 illustrating the arrangement of M1 and M2 slopes and the directing of the M1 slope to the incidence side face of the light guide.

To further emphasize these slope features, independent claim 4 has been further amended to clarify that the first slopes are light source side slopes and the second slopes are exiting-surface slopes. These amendments correspond to the specification on page 10, lines 9-11, where light source side slopes M1 are directed to incidence end face T of light guide plate 2 and exiting-surface slopes M2 are directed oppositely to incidence end face T of light guide plate 2.

Similarly, the above mentioned figures clearly support the claimed second slope being inclined with respect to the plane of the light control element and directed oppositely to said incidence end face of the light guide plate. FIGS. 3 and 6-8 clearly illustrate slope M2 being sloped away from the incidence side face.

As detailed on page 10, line 15, through page 11, line 3, slopes M1 are not described as being diffusible slopes, but indicates that M2 are diffusible. Further, applicants respectfully direct the Examiner to compare FIG. 2 with FIGS. 6 –8, noting that, in this illustrated embodiment, diffusible slopes are denoted by thick lines distinguishable from thin lines denoting non-diffusible slopes.

Thus, the claimed first and second slopes are supported by the outstanding specification. In addition, applicant is permitted to define elements as desired.

Here, a slope directed to the incidence end face of the light guide plate is sloped such that light proceeding from the incidence end face, in a direction away from the incidence end face, would radiate on the first slope directed to the incidence end face.

Similarly, a slope directed oppositely to said incidence end face of the light guide plate would be oriented such that light proceeding from the incidence end face, and reflected in a general direction back toward the incidence end face, would radiate on the second slope directed oppositely to the incidence end face. Here, applicant's defining of terms is appropriate and must be considered. See *Honeywell Inc. v. Victor Co. of Japan Ltd.*, 63 USPQ2d 1904 (CA FC 2002) "The district court erred in not according more weight to the inventor's definition. It is well settled that a patentee may define a claim term either in the written description of the patent or, as in the present case, in the prosecution history. *Mycogen Plant Science v. Monsanto Co.*, 243 F.3d 1316, 1327, 58 USPQ2d 1030, 1039 (Fed. Cir. 2001). Frequently, a definition offered during prosecution is made in response to a rejection, and is entered in conjunction with a narrowing amendment. See, e.g., *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1677 (Fed. Cir. 1995). Such a definition limits the scope of the claim, preventing the patentee from later recapturing what was previously surrendered. Although the inventor's definition does not have a narrowing effect, it is nonetheless relevant in indicating the meaning that the inventor ascribed to the term. See *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996) ('[T]he record before the Patent and Trademark Office is often of critical significance in determining the meaning of the claims.').

Thus, as defined herein and by the claims, the claimed first and second slopes are disclosed and supported by the present specification.

The Office Action has indicated that the specification has never indicated that the second slope is the diffusible surface, as claimed. The Office Action sets forth that only the first slope is disclosed as the diffusible surface. However, page 12, lines 26-34, clearly support the first or second slopes being diffused. In addition, the specification on page 10, line 15, to page 11, line 3, says M2 slopes are diffusible.

Thus, the Office Action has mischaracterized the first and second claimed slopes, thereby negating the remaining §112 rejections.

It is noted that the Examiner may have misunderstood the specification disclosed invention. Diffused slopes M2 diffuse light after that light has progressed through slope M1 of the light control member 12, i.e., the back surface of slopes M2 can diffuse incident light while that light is within the light control element (prism sheet) 12.

The Examiner is also cautioned to review the illustrated figures with care, as some figures are upside down, i.e., their Z axis is opposite.

REJECTION UNDER 35 USC 112, ENABLEMENT

Lastly, the Office Action has indicated that the specification is not enabling for using the first and/or second diffusible slopes.

However, it is not necessary that the application describe the claim limitations exactly, but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations. In re Wertheim, 191 USPQ 90, 96 (CCPA 1976). Similarly, "[the specification] need only be reasonable with respect to the art involved; they need not inform the layman nor disclose what the skilled already possess. They need not describe the conventional... The intricacies need not be detailed ad absurdum." General Electric Co. v. Brenner, 159 USPQ 335 (D.C. Cir. 1968). In addition, a defining aspect of enablement is that there isn't undue experimentation, i.e., experiment required to reproduce the claimed features is satisfactory, as long as it isn't undue experimentation. In re Geerdes, 180 USPQ 789, 793 (CCPA 1974).

Accordingly, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art, after review of the present invention and disclosure, implement the diffused slopes as claimed.

Again, it is noted that an amount of experiment required to reproduce the claimed features is acceptable, as long as it isn't undue experimentation.

In addition, as noted in MPEP § 2163.04, a "description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption." The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The Examiner has the initial burden or presenting by the a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention as defined by the claims.

MPEP § 2163.04(I) further details that in rejecting a claim, "the examiner must set forth express findings of fact which support the lack of written description." As further detailed, "[t]hese findings should: (a) Identify the claim limitation at issue; and (B) Establish a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as filed. A general allegation of 'unpredictability in the art' is not a sufficient reason to support a rejection for lack of adequate written description."

Further see MPEP § 2163.04(II), where the Examiner is required to "consider the record as a whole, including amendments, arguments, and any evidence submitted by applicant," before reissuing a § 112 description rejection.

It is respectfully submitted that the outstanding Office Action has failed to meet the required burden for the set forth enablement rejection.

CONCLUSION

Therefore, in view of the foregoing, it is respectfully submitted that the pending claims are in allowable condition.

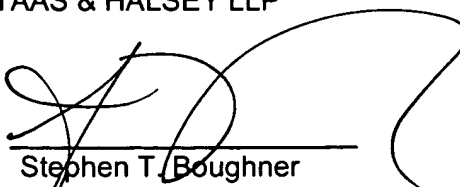
If additional information is requested of the applicant, the Examiner is respectfully requested to contact the undersigned.

If there are any additional fees associated with filing of this Preliminary Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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